No. 15608

United States Court of Appeals

for the Ninth Circuit

VINCENT I. WHITMAN,

Appellant,

vs.

WALT DISNEY PRODUCTIONS, INC.,

Appellee.

Transcript of Record

Appeal from the United States District Court for the Southern District of California Central Division

Phillips & Van Orden Co., 4th & Berry, San Francisco, Calif.—4-4-58

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[Clerk's Note: When deemed likely to be of an important nature, errors or doubtful matters appearing in the original certified record are printed literally in italic; and, likewise, cancelled matter appearing in the original certified record is printed and cancelled herein accordingly. When possible, an omission from the text is indicated by printing in italic the two words between which the omission seems to occur.]

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NAMES AND ADDRESSES OF ATTORNEYS

For Appellant:

VINCENT I. WHITMAN,
Pro Se;

JULIAN A. MARTIN,
Power of Attorney,
200 East End St.,
New York City, New York.

For Appellee:

LYON & LYON,
811 West 7th Street,
Los Angeles 17, California.

In the District Court of the United States for the Southern District of California, Central Division

No. 15764

VINCENT I. WHITMAN,

Plaintiff,

vs.

WALT DISNEY PRODUCTIONS, INC., a Corporation; WALTER E. DISNEY, an Individual; ROY O. DISNEY, an Individual; JOHN DOE ONE, JOHN DOE TWO, JOHN DOE THREE, JOHN DOE FOUR, JOHN DOE FIVE, JOHN DOE SIX, JOHN DOE SEVEN, JOHN DOE EIGHT, JOHN DOE NINE, JOHN DOE TEN, and JANE DOE ONE, JANE DOE TWO, JANE DOE THREE, and JANE DOE FOUR,

Defendants.

COMPLAINT FOR INFRINGEMENT OF PATENT

Comes Now, the plaintiff herein, Vincent I. Whitman, and for cause of action against the defendants herein, and each of them, alleges as follows, to wit:

I.

The jurisdiction of this Court is based upon the Patent Laws of the United States of America; that the acts of infringement hereinafter complained of were committed in the City of Los Angeles, County of Los Angeles, State of California; within the Cen-

tral Division of the above-entitled Court, and elsewhere within the United States.

II.

That the plaintiff, Vincent I. Whitman, is a citizen of the United States and an inhabitant thereof, that he resides in the State of New York, namely, New York City.

III.

That the Walt Disney Productions, Inc., is a Corporation duly organized and existing under and by virtue of the Laws of the State of California; with its principal place of business in the City of Los Angeles, County of Los Angeles, State of California;

That defendant, Walt Disney Productions, Inc., was chartered on or about the 29th day of September, 1938, to succeed, and did succeed, certain theretofore existing Corporations, including Walt Disney Productions, Ltd.

That said Walt Disney Productions, Inc., was at the time of its Incorporation known as Walt Disney Enterprises, Inc., but on January 1st, 1929, as plaintiff is informed and believes, the Corporate name was changed to Walt Disney Productions, Inc.

That the said Walt Disney Productions, Inc., and its predecessor, Walt Disney Productions, Ltd., is, and was, and is still engaged extensively in the motion picture industry, and particularly in the production, sale and distribution of cinematographic films and pictures and animated cartoon productions;

That defendants, Walter E. Disney, and Roy O. Disney, are individuals residing in the County of Los Angeles, State of California; that the defendant, Roy O. Disney, is the president of the defendant Corporation * * * and directs and controls the same in conjunction with defendant, Walter E. Disney, who is said Corporation's Chairman of the Board of Directors thereof; that the defendants, John Does, one to ten, and the defendants, Jane Does, one to four, are sued herein under fictitious names, as the true names of said defendants are not known to plaintiff, and plaintiff will ask leave of the Court to insert their true names as soon as they are ascertained;

That the said defendants, and each of them, have jointly and severally committed the various unlawful acts herein complained of * * * and have infringed upon the plaintiff's Letters Patent hereinafter described.

IV.

That on March 30th, 1937, United States Letters Patent Number 2,075,684 were duly and legally issued to plaintiff for an invention in the composite system of photography, particularly motion picture photography wherein, among other things, a portion of a still background scene pictorially recorded is photographed in a superimposed relation on the visual actions which occur in the foreground; and since that date, plaintiff has been, and still is, the owner of those Letters Patent.

VI.

That defendants have, within the last ten years, and prior to the filing of this complaint, and subsequent to March the 30th, 1937, infringed said Letters Patent by making, or causing to be made, selling and licensing, or causing to be sold or licensed, at its regular place of business in the County of Los Angeles, State of California, and elsewhere in the United States, the motion pictures "Snow White and the Seven Dwarfs," "Pinocchio," "Bamby," "Fantasia," "Peter Pan," "Cinderella," a reissue of the picture "Snow White" and many and sundry others, which pictures were made in accordance with and embodying the invention set forth in said Letters Patent Number 2,075,684; and that defendants will continue to infringe said Letters Patent unless enjoined by this Court; plaintiff asks that this Honorable Court issue a restraining Order preventing the defendants from further infringement pending the trial of this action.

VII.

That plaintiff has notified defendants of said Letters Patent and of defendant's infringement thereof, but in spite of said notice, said defendants continued such infringement, and still continue to do so.

VIII.

That defendants have derived gains and profits from such infringement which plaintiff should have otherwise received but for such infringement and have thereby caused irreparable damage to plaintiff, and to his damage in the sum of $10,000,000.

Wherefore: Plaintiff prays judgment against the within-named defendants, and each of them as follows:

(1) For an injunction restraining defendants and all persons controlled by said defendants against infringing upon or violating said Letters Patent as alleged and set forth in this complaint;

(2) For an accounting of the profits and damages, and upon the actual damages being ascertained in excess of the sum of $10,000,000; and that the amount thereof be trebled in view of the wilful infringement by said defendants;

(3) For the sum of $10,000,000 actual damages sustained by plaintiff;

(4) For the costs incurred in the prosecution of this action;

(5) For such other and further relief as to this Honorable Court shall be deemed meet and proper in the premises.

/s/ VINCENT I. WHITMAN,
Plaintiff.

/s/ WILLIAM J. F. BROWN,
Attorney for Plaintiff.

Duly verified.

[Endorsed]: Filed July 30, 1953.

[Title of District Court and Cause.]

ALIAS SUMMONS

To the above-named Defendant:

You are hereby summoned and required to serve upon Wm. J. F. Brown, plaintiff's attorney, whose address is: 229 North Broadway, Los Angeles 12, California, (Telephone: MUtual 4797) an answer to the complaint which is herewith served upon you, within twenty days after service of this summons upon you, exclusive of the day of service. If you fail to do so, judgment by default will be taken against you for the relief demanded in the complaint.

[Seal] EDMUND L. SMITH,
Clerk of Court.

/s/ L. GUNLIFFE,
Deputy Clerk.

Date: January 17, 1955.

Returns on service of Writ attached.

[Endorsed]: Filed February 8, 1955.

[Title of District Court and Cause.]

ANSWER

Come now defendants, Walt Disney Productions, Walter E. Disney and Roy O. Disney, above named, and answering the Complaint herein, allege:

I.

Answering Paragraph I of said Complaint, defendants admit that the jurisdiction of this Court is based upon the Patent Laws of the United States of America, but defendants deny that they have, either individually or jointly or severally, committed any act of infringement of Letters Patent No. 2,-075,684, in the City of Los Angeles, County of Los Angeles, State of California, or elsewhere within the United States.

II.

Answering Paragraph II of the Complaint, defendants are without knowledge as to the citizenship and habitation of plaintiff, and basing their answer upon that ground, deny the allegation and require strict proof thereof.

III.

Answering Paragraph III of the Complaint, defendants admit that Walt Disney Productions is a corporation duly organized and existing under and by virtue of the laws of the State of California, that its principal place of business is in the City of Los Angeles, County of Los Angeles, State of California; state that Walt Disney Enterprises, Inc., is the successor to Walt Disney Productions, Ltd., and that its name was changed to Walt Disney Productions; further state that the defendant Walt Disney Productions and its predecessor Walt Disney Productions, Ltd., was and defendant Walt Disney Productions still is engaged in the motion picture industry and particularly, among other things, in the produc-

tion, sale and distribution of cinematographic films and pictures and animated cartoon productions;

Defendants admit that Walter E. Disney and Roy O. Disney are individuals residing at Los Angeles, Los Angeles County, State of California; that Roy O. Disney is the President of Defendant Corporation, and that Walter E. Disney is Chairman of the Board of Directors of said Defendant Corporation, and that in such capacity Roy O. Disney and Walter E. Disney perform the acts generally performed by such officers and members of the Board of Directors, but deny that they performed any act or acts in the management, control or directing the activities of said Corporation, Walt Disney Productions, other than those generally performed in such capacity as president and chairman of the Board of Directors, of said Corporation, Walt Disney Productions, and defendants, Walter E. Disney and Roy O. Disney and Walt Disney Productions, each of them and together, deny that they, or either or any of them, have jointly or severally committed any act of infringement of Letters Patent No. 2,075,684 in suit, or have committed any unlawful acts complained of in the Complaint herein.

IV.

Answering Paragraph IV of the Complaint herein, defendants admit that Letters Patent No. 2,075,684 were issued on March 30, 1937, to plaintiff for an alleged invention in a composite system of photography, but deny that said Letters Patent were duly and legally issued, and state that defendants,

and each of them, are without knowledge or information sufficient to form a belief as to the ownership of the said purported Letters Patent No. 2,075,684.

V.

Answering Paragraph V of the Complaint, defendants and each of them deny that they have, within the last ten years, or at any time, or prior to the filing of the Complaint herein, or subsequent to March 30, 1937, committed any act or acts of infringement of the said Letters Patent No. 2,075,684, or that said defendants, or either of them, have jointly or severally infringed the said Letters Patent No. 2,075,684 by making or causing to be made, selling or licensing, or causing to be sold or licensed, at its regular place of business in Los Angeles, County of Los Angeles, State of California, or at any place in the United States, the motion pictures "Snow White and the Seven Dwarfs," "Pinocchio," "Bamby," "Peter Pan," "Cinderella," a reissue of the picture "Snow White," or any other motion picture, and specifically deny that the above-identified motion pictures or any pictures made by defendants were made in accordance with or embodying the alleged invention allegedly set forth in said Letters Patent No. 2,075,684, and said defendants deny that they will continue to infringe the said Letters Patent unless enjoined by this court.

VI.

Answering Paragraph VI of the Complaint, admit notice from plaintiff of their alleged infringement

of said Letters Patent No. 2,075,684, but deny each and every other allegation of said paragraph.

VII.

Answering Paragraph VII of the Complaint, defendants deny that they have derived unlawful gains and profits from any act or acts of infringement of the Letters Patent No. 2,075,684, or that defendants have received any profits or gains which should have otherwise been received by plaintiff, or that said defendants have caused plaintiff irreparable damage.

Further answering the Complaint herein, and for separate, alternate and further defenses, defendants allege:

VIII.

United States Letters Patent No. 2,075,684 were invalid and void in that the subject matter thereof is not an invention and the claims thereof fail to recite an invention as required by Sections 100 and 101 of Title 35 of the United States Code, and in this connection no inventive act was performed by the named inventor in said patent in producing such alleged invention.

IX.

United States Letters Patent No. 2,075,684 were invalid and void in that prior to any supposed invention or discovery by plaintiff, the thing or things alleged to be patented by said Letters Patent No. 2,075,684 had been patented or described in prior printed publications or prior Letters Patent before

the alleged invention or discovery thereof by plaintiff, the title, date and page numbers of such publications and the country, number, date and name of the patentee of said patents will be supplied at least thirty days before the trial of this action.

X.

United States Letters Patent No. 2,075,684 were invalid and void in that prior to the supposed invention or discovery by Vincent I. Whitman that which is alleged to be patented in and by said Letters Patent No. 2,075,684, and particularly that which is described and claimed therein, and all material and substantial parts thereof, had in the United States been invented, used by or known by others having prior knowledge and having previously used the invention, the names and addresses of such persons will be supplied at least thirty days before the trial of this action.

XI.

Defendants allege that in view of the state of the art at the time and prior to the Letters Patent in suit, that the claims of said Letters Patent cannot be construed to bring within the purview thereof as an infringement thereof any device, method or process used by these defendants, or any of them.

XII.

Defendants allege upon information and belief that while the application for said Letters Patent No. 2,075,684 was pending in the United States Patent Office the applicant therefor so limited, confined

and represented the claims of the application for said Letters Patent to be directed to a particular apparatus or method that the said applicant and plaintiff is forever estopped and cannot now seek to, or obtain, a construction for said Letters Patent or any of the claims thereof sufficiently broad to cover any process or apparatus or method either made, used or sold, or caused to be made, used, or sold, by these defendants, or any of them.

XIII.

Defendants allege that the description of the said invention or inventions in the specification of the Letters Patent No. 2,075,684 is not in such full, clear, concise and exact terms as to enable any person skilled in the art, or with which it is most clearly connected, to practice the invention therein allegedly defined and set forth.

XIV.

Defendants allege that any recovery on any cause of action based upon acts complained of prior to July 30, 1947, is barred by the time limitation set forth in Section 286, Title 35, United States Code.

XV.

Defendants allege that on September 30, 1939, in the District Court of the Southern District of New York, Civil Action No. 5/478 entitled Vincent I. Whitman vs. Walt Disney Productions, Inc., Technicolor, Inc., Technicolor Motion Picture Corporation and R K O Radio Pictures, Inc., was filed charging infringement of Letters Patent No. 2,075,-

684, here in suit, and further asserting that the motion pictures "Snow White and the Seven Dwarfs" and "Pinocchio" constituted an infringement of said Letters Patent, and that said civil action was subsequently dismissed; that on May 8, 1940, Civil Action 947B entitled Vincent I. Whitman vs. Walt Disney Productions, Inc., a corporation; Walter E. Disney, an individual, and Roy O. Disney, an individual, was filed charging the defendants in this suit with infringement of United States Letters Patent No. 2,075,684, by the production and sale of the motion pictures "Snow White and the Seven Dwarfs" and "Pinocchio"; that said civil action was dismissed for lack of prosecution, Judgment being entered March 30, 1943; that by virtue of the long delay involved in the bringing of the present action after plaintiff had full knowledge of the alleged activities of the defendants and because of the prior bringing of two actions based upon the asserted infringement by defendants and because of the dismissal of these actions, defendants have been led to believe that plaintiff had abandoned any claims asserted in this Complaint, and in reliance thereon defendants have changed their position, causing the motion pictures complained of to be reissued and producing further motion pictures, employing the alleged infringement of Letters Patent No. 2,075,684. As result of the long delay and the change of position in reliance thereon by defendants, plaintiff is barred by laches.

Wherefore, these defendants deny that the plaintiff is entitled to the relief prayed for in said Com-

plaint, and pray for a decree adjudicating that United States Letters Patent No. 2,075,684 were invalid and void, and that none of the defendants have infringed said Letters Patent and that plaintiff take nothing by his Complaint herein, that the action be dismissed and that the court award to these defendants costs and attorneys' fees herein incurred and for such other and further relief as the court may deem just and proper.

WALT DISNEY
PRODUCTIONS,
WALTER E. DISNEY,
ROY O. DISNEY,
Defendants;

By /s/ LEONARD S. LYON,
Their Attorney.

Affidavit of service by mail attached.

[Endorsed]: Filed February 24, 1955.

[Title of District Court and Cause.]

STIPULATION

Come now the parties to the above-entitled case by their respective attorneys and stipulate as follows:

1. That in lieu of the taking of the deposition of plaintiff Vincent I. Whitman before a Notary Public in Los Angeles, California, as heretofore noticed, that the plaintiff will appear and give his deposition before a proper officer in New York City, New

York, at such time and place as may be fixed there by the attorneys for defendants upon ten days' written notice given by attorneys for defendants to attorneys for plaintiff.

* * *

3. That the pretrial hearing in this action be continued to October 3, 1955, at 10:00 a.m., following the taking of the deposition of plaintiff Vincent I. Whitman in New York City as aforesaid, subject to the convenience of the Court at the time.

Dated this 25th day of May, 1955.

/s/ WM. J. F. BROWN,

/s/ JULIAN A. MARTIN,
Attorneys for Plaintiff.

/s/ LEONARD S. LYON,

/s/ R. DOUGLAS LYON,
Attorneys for Defendants Walt Disney Productions, Inc., Walter E. Disney and Roy O. Disney.

Approved and So Ordered this 26th day of May, 1955.

/s/ WM. M. BYRNE,
United States District Judge.

[Endorsed]: Filed May 26, 1955.

[Title of District Court and Cause.]

NOTICE OF MOTION

To Vincent I. Whitman and William J. F. Brown, his attorney:

You, and each of you, will take notice that on Monday, December 19, 1955, at 10:00 a.m. in the courtroom of the Honorable William M. Byrne, in the United States Post Office and Court House Building, in the City of Los Angeles, State of California, or as soon thereafter as counsel can be heard, defendants will bring on for hearing the accompanying Motion under Rule 42(b) of the Federal Rules of Civil Procedure.

WALT DISNEY
PRODUCTIONS, INC.,
WALTER E. DISNEY,
ROY O. DISNEY,
Defendants;

By /s/ LEONARD S. LYON,

/s/ ROBERT DOUGLAS LYON,
Their Attorneys.

[Title of District Court and Cause.]

MOTION UNDER RULE 42(b) FEDERAL RULES OF CIVIL PROCEDURE

Comes Now the defendants in the above-entitled case, through their attorneys, and move this Court for an order, pursuant to Rule 42(b) of the Federal Rules of Civil Procedure, for a separate trial on the issue of laches as asserted in paragraph 15 of defendants' Answer to the Complaint in this action

in advance of the trial of any other issue involved in this case.

This motion is based upon the pleadings on file in this action and the accompanying Memorandum of Points and Authorities.

WALT DISNEY
PRODUCTIONS, INC.,
WALTER E. DISNEY,
ROY O. DISNEY,
Defendants;

By /s/ LEONARD S. LYON,

/s/ ROBERT DOUGLAS LYON,
Their Attorneys.

[Endorsed]: Filed December 8, 1955.

[Title of District Court and Cause.]

STIPULATION OF FACTS

The following facts are stipulated by and between the respective parties through their counsel for the purpose of the trial of this action:

1. That Civil Action Doc. 5/478 was filed on September 30, 1939, in the District Court for the Southern Division of New York, entitled Vincent I. Whitman vs. Walt Disney Productions, et al.

2. That Civil Action Doc. 5/478 involved the same party plaintiff and the same party defendant,

17. That plaintiff Vincent I. Whitman has not been employed from September 30, 1939, to July 30, 1953, and his income has been derived from the selling and licensing of his inventions during this period of time.

18. That the following portions of the deposition of Vincent I. Whitman taken in New York, New York, on September 22, 1955, are admitted into evidence:

Page 2, line 5, to page 10, line 5, inclusive;
Page 15, line 18, to page 29, line 10, inclusive;
Page 61, line 17, to page 66, line 5, inclusive.

WALT DISNEY
PRODUCTIONS, INC.,
WALTER E. DISNEY,
ROY O. DISNEY,
Defendants;

By /s/ LEONARD S. LYON,

/s/ ROBERT DOUGLAS LYON,
Their Attorneys.

/s/ WM. J. F. BROWN,
Attorney for Plaintiff.

[Endorsed]: Filed August 31, 1956, U.S.D.C.

[Endorsed]: Filed July 13, 1957, U.S.C.A.

[Title of District Court and Cause.]

OPINION

Appearances:

WILLIAM J. F. BROWN, ESQ.,
229 North Broadway,
Los Angeles 12, California.
EDWARD D. BOLTON, ESQ.,
565 Fifth Avenue,
New York, N. Y.,
Attorneys for Plaintiff.

LYON & LYON,
LEONARD S. LYON,
ROBERT DOUGLAS LYON,
811 West Seventh Street,
Los Angeles 17, California,
Attorneys for Defendants.

Suit is brought for infringement of United States Letters Patent No. 2,075,684, issued March 30, 1937, to plaintiff, the present owner, covering systems of composite motion picture photography. It is alleged that defendants, in producing certain motion pictures since 1937 including Snow White, Pinocchio, Fantasia, Peter Pan, Cinderella and many others, have infringed this patent.

On motion of defendants the case was set for trial on the issue of laches only, under Rule 42(b). The case is submitted on a stipulation of facts, including certain portions of plaintiff's deposition. The complaint seeks an injunction plus an accounting of

profits and damages. Subsequent to the commencement of the action the patent in suit expired. Although the question of injunctive relief is thus no longer involved, laches may nevertheless constitute a bar to recovery of profits and damages. Gillons vs. Shell Co. of California, 86 F. 2d 600 (CA9 1936); Banker vs. Ford Motor Co., 69 F. 2d 665.

Plaintiff has admittedly been aware of the method employed by defendant since prior to September, 1939. Two previous suits have been brought against these defendants for infringement of this same patent. The first was filed in the United States District Court for the Southern District of New York in 1939 and was dismissed for improper venue. The second was begun in this court in 1940 and was dismissed without prejudice in 1943 for want of prosecution. It is admitted that from 1943 until the filing of the present suit in 1953 no other actions involving this patent were filed or pending, nor did plaintiff or any of his representatives assert any claim of infringement of the patent either verbally or otherwise against defendants.

During this period plaintiff was of sound health mentally and physically, was not confined in any type of institution, nor absent from the United States. Plaintiff was single at all times, and not financially destitute. It is admitted that during this period the only new acts of alleged infringement consisted of the production of additional films using the same process.

The only question now before the court is whether or not plaintiff's claim is barred by laches. Although there is no fixed period (except as provided in 35 U.S.C.A. §286) limiting the time within which suit for infringement must be brought, diligence must be observed to escape a charge of laches. Whether the plaintiff has been diligent under all the circumstances decides the question of laches. The mere lapse of time is not conclusive. Where plaintiff is chargeable with laches, he cannot recover the damages he has suffered nor the profits defendant has gained. [Walker on Patents (Deller's Edition), Vol. 4, p. 2658.]

The leading decision in this circuit on the question of laches in infringement actions is Gillons vs. Shell Co. of California, supra. The principles therein enunciated as underlying the determination of this problem were recently reaffirmed in Kimberly Corporation vs. Hartley Pen Company, 237 F. 2d 294 (CA9 1956).

"The question of laches is addressed to the sound discretion of the trial judge." Although not bound by statutes of limitations relating to actions at law, courts of equity will generally draw analogies to them. In patent cases, the "analogous" period is six years. [35 U.S.C.A. §286.] After this length of time, the delay is presumed to have injured defendant, unless the contrary can be shown by plaintiff. [Gillons vs. Shell Co. of California, supra; Westfall Larson Co. vs. Allman-Hubble Tug Boat Co., 73 F. 2d 200 (CA9 1934).]

But aside from this analogy to the statute of limitations, there is an "all-embracing" doctrine of equity which gives the court discretion to invoke the bar of laches. Equity frowns on stale claims, and unreasonable delay in bringing suit precludes relief. Reasonable diligence is a prerequisite to invoking the court's aid in the assertion of one's rights. [Gillons vs. Shell Co. of California, supra.]

In the present case we find an extended period of apparent inactivity by plaintiff, running well beyond the analogous statutory period. The burden is thus cast upon plaintiff to justify the long delay.

Plaintiff first argues that he has in fact been diligent in the assertion of his rights. But his inactivity clearly demands explanation. All that is offered is a statement of counsel asserting that from the time of dismissal in 1943 there has been voluminous correspondence between plaintiff and his counsel and many trips by plaintiff's business agent and others from New York to California in preparation to proceed with the present action. This falls far short of showing diligence during the long period of apparent inactivity.

Nor has plaintiff satisfactorily explained this absence of diligence. In fact the only excuse offered is an alleged lack of funds. By the weight of authority, lack of funds is no excuse for delay in bringing suit. [Leggett vs. Standard Oil, 149 U.S. 287, 294, 13 S.Ct. 902, 905, 37 L.Ed. 737; Hayward vs. National Bank, 96 U.S. 611, 618, 24 L.Ed. 855; Cummings vs. Wil-

son & Willard Mfg. Co., 4 F. 2d 453 (CA9 1925); Gillons vs. Shell Co. of California, supra.]

In Cummings vs. Wilson & Willard Mfg. Co., supra, the court found this rule particularly applicable where plaintiff's delay appeared to be an acquiescence in the alleged infringement. Plaintiff in that case argued that two other decisions of this circuit compelled a different holding. [Los Alamitos Sugar Co. vs. Carroll, 173 F. 280; Columbia Graphaphone Co. vs. Searchlight Horn Co., 236 F. 135.] In distinguishing these cases, the court indicated that laches might not be imputed where defendant knows plaintiff does not acquiesce or where plaintiff carries his protests as far as his funds will allow, even though unable to undertake litigation. In such circumstances, plaintiff's poverty may excuse delay in instituting suit.

Such is not the case here. In the first place, plaintiff's contention that the delay was due to lack of funds is not convincing. In fact, his own testimony rather clearly negates it. He admits that his brother, who completely handled all his business affairs, could have financed the action. Further, it appears that plaintiff's own income was sufficient to have allowed the litigation to be maintained. Plaintiff in addition testified that during the period of delay he could have obtained, had he so chosen, employment with many motion picture companies at a substantial salary. Plaintiff has failed to establish that he lacked funds to proceed with the litigation, thus

failing to show the exceptional circumstances necessary to avoid the bar of laches.

But assuming, arguendo, that plaintiff was handicapped by lack of funds in proceeding with actual litigation, he has still not shown the "reasonable diligence" required of one seeking relief in a court of equity. From the time of dismissal in 1943 not a single protest or assertion of rights was made to defendant. Even after filing this suit in 1953 no attempt was made to serve the summons for nearly two years. We find then an apparent acquiescence or abandonment of plaintiff's claim that cannot be ascribed to financial inability. No other excuse for this period of delay having been shown, plaintiff fails to evade the bar which his lack of diligence has raised.

During these many years plaintiff has not exploited his alleged invention. Defendants, on the other hand, have invested millions of dollars of time, effort and capital in establishing Walt Disney movies as an American institution. This venture has paid handsome rewards, not only in profit to defendants but in entertainment to millions of children and adults the world over. Whatever claim plaintiff may have had for originating or perfecting this new form of art, defendants alone were responsible for making it a commercial success. Plaintiff failed for over a decade to assert his alleged claim. At this late hour he now demands that the defendants account to him for the profits of the venture. This plea is not one calculated to find sympathetic reception in a court of

equity. It is the judgment of this court that plaintiff's unreasonable delay constitutes laches barring the maintenance of this action. Judgment of dismissal is hereby ordered.

Counsel for defendants is directed to prepare findings and judgment of dismissal under the rules of this court.

Dated: This 15th day of January, 1957.

/s/ BEN HARRISON,
Judge.

[Endorsed]: Filed January 16, 1957.

In the United States District Court, Southern District of California, General Division

Civil Action No. 15764—BH

VINCENT I. WHITMAN,

Plaintiff,

vs.

WALT DISNEY PRODUCTIONS, INC., a Corporation; WALTER E. DISNEY, an Individual; ROY O. DISNEY, an Individual; JOHN DOES ONE to FOUR, Inclusive; JANE DOES ONE to FOUR, Inclusive,

Defendants.

FINDINGS OF FACT AND CONCLUSION OF LAW AND JUDGMENT

This cause having come on to be heard before the court, solely upon the issue of laches, pursuant to the provision of Rule 42-B F.R.C.P., and the case

having been submitted on a stipulation of fact and on portions of the plaintiff's deposition, the briefs of the parties having been filed, the court hereby makes its findings of fact, conclusions of law and judgment:

Findings of Fact

1.

That the plaintiff, Vincent I. Whitman, is a citizen of the United States and resides in the City of New York, State of New York.

2.

That defendant, Walt Disney Productions, is a corporation duly organized and existing under and by virtue of the laws of the State of California, that its principal place of business is in the City of Los Angeles, County of Los Angeles, State of California. That Walt Disney Enterprises, Inc., is the successor to Walt Disney Productions, Ltd., and its name was changed to Walt Disney Productions. That the defendant, Walt Disney Productions and its predecessor, Walt Disney Productions, Ltd., was and defendant Walt Disney Productions is still engaged in the motion picture industry.

3.

That defendants, Walter E. Disney and Roy O. Disney, are individuals residing in the City of Los Angeles, County of Los Angeles, State of California.

4.

That this court has jurisdiction over the subject matter inasmuch as this is an action arising under the patent laws of the United States.

5.

That plaintiff, Vincent I. Whitman, is the owner of patent No. 2,075,684 issued March 30, 1937, which patent expired March 30, 1954.

6.

That Civil Action Doc. 5/478 was filed on September 30, 1939, in the District Court for the Southern Division of New York, entitled Vincent I. Whitman vs. Walt Disney Productions, et al.

7.

That Civil Action Doc. 5/478 involved the same party plaintiff and the same party defendant, Walt Disney Productions, as in the present action, in addition to other parties defendant.

8.

That Civil Action Doc. 5/478 included an identical claim for infringement by defendants of Whitman Patent 2,075,684, as in the present action.

9.

That in Civil Action Doc. 5/478 the same method and apparatus of composite motion picture photography of the defendant Walt Disney Productions, Inc., was charged to constitute an infringement of Whitman Patent 2,075,684, as in the present action.

10.

That Civil Action Doc. 5/478 was dismissed by an order dated December 15, 1939, consented to by plaintiff.

11.

That Civil Action No. 947-BH was filed on May 8, 1940, in the District Court for the Southern District of California, entitled Vincent I. Whitman vs. Walt Disney Productions, Inc., a corporation; Walter E. Disney, an individual, and Roy O. Disney, an individual.

12.

That Civil Action No. 947-BH involved the identical parties as the present action.

13.

That Civil Action No. 947-BH included an identical claim for infringement by defendants of Whitman Patent 2,075,684 as in the present action.

14.

That in Civil Action No. 947-BH the same method and apparatus of composite picture photography of the defendants' was charged to constitute an infringement of Whitman Patent 2,075,684, as in the present action.

15.

That Civil Action No. 947-BH was dismissed by an order of Judge Harrison dated March 30, 1943.

16.

That no other actions were filed or pending in any court from March 30, 1943, until July 30, 1953, involving the parties to this action.

17.

That neither plaintiff nor his representatives asserted any claim of infringement of Whitman Pat-

ent 2,075,684 either verbally or by any written communication against defendants or any of them from March 30, 1943, to July 30, 1953.

18.

That during the period March 30, 1943, to July 30, 1953, the plaintiff, Vincent I. Whitman, was of sound health both mentally and physically.

19.

That during the period March 30, 1943, to July 30, 1953, the plaintiff, Vincent I. Whitman, was not confined in any type of institution and was not absent from the United States.

20.

That during the period March 30, 1943, to July 30, 1953, the plaintiff, Vincent I. Whitman, was a single man and had no dependents and was not financially destitute.

21.

That plaintiff Vincent I. Whitman was aware of the method and apparatus used by defendants, now charged to constitute an infringement of Whitman patent 2,075,684 prior to September 30, 1939.

22.

That plaintiff Vincent I. Whitman has offered no excuse for the delay in instituting this action.

23.

Plaintiff Vincent I. Whitman has not been diligent in the exertion of his rights.

Conclusions of Law

I.

That the plaintiff is barred by laches from maintaining this action.

II.

That a judgment of dismissal of the action be entered herein with costs in favor of defendants.

Judgment

In accordance with the foregoing findings and conclusions, it is ordered adjudged and decreed:

I.

That the above-entitled action is hereby dismissed.

2.

That defendants recover from plaintiff the taxable costs of defendants in this court and that defendants shall have judgment for such costs.

/s/ BEN HARRISON,
United States District Judge.

Dated this 29th day of January, 1957.

Approved as to form:

WILLIAM J. F. BROWN, ESQ.,

By /s/ .....,
Attorney for Plaintiff.

Affidavit of service by mail attached.

Lodged January 21, 1957.

[Endorsed]: Filed January 29, 1957.

Docketed and entered January 30, 1957.

United States District Court, Southern District of California, Central Division

William J. F. Brown, Esq.,
229 North Broadway,
Los Angeles 12, Calif.

Lyon & Lyon, Esqs.,
811 West 7th St.,
Los Angeles 17, Calif.

Re: Whitman vs. Walt Disney Productions, Inc., et al., No. 15764—BH.

You are hereby notified that judgment has been docketed and entered this day in the above-entitled case.....

Dated: Los Angeles, Calif., January 30, 1957.

By /s/ C. A. SIMMONS,
Deputy Clerk.

[Title of District Court and Cause.]

NOTICE OF APPEAL

Notice Is Hereby Given that Vincent I. Whitman, the plaintiff above named, hereby appeals to the United States Court of Appeals, Ninth Circuit, from the judgment entered in the above-entitled action on the 30th day of January, 1957.

Dated: March 1, 1957.

/s/ HARRISON M. DUNHAM,
Attorney for Plaintiff.

Affidavit of service by mail attached.

[Endorsed]: Filed March 1, 1957.

[Title of District Court and Cause.]

ORDER EXTENDING THE TIME FOR FILING AND DOCKETING THE RECORD ON APPEAL

Upon application of the Clerk, good cause appearing,

It Is Ordered that the time for filing and docketing, with the United States Court of Appeals, the record on the appeal taken by Plaintiff in the above-entitled cause, is hereby extended to and including May 29, 1957.

Dated: April 10, 1957.

/s/ LEON R. YANKWICH,
Chief Judge.

[Endorsed]: Filed April 10, 1957.

[Title of District Court and Cause.]

DEPOSITION OF PLAINTIFF
VINCENT I. WHITMAN
taken by the Defendants by consent.

September 22, 1955

* * *

It Is Hereby Stipulated and Agreed by and between the parties hereto, through their respective counsel, that the within deposition may be signed before any notary public with the same force and effect as if signed and sworn to before the Court;

It Is Further Stipulated and Agreed that a copy of the within deposition shall be furnished to the attorney for the plaintiff, without charge.

Mr. Caughey: Let the record show that the witness is being produced at the request of the defendants and without the necessity of any notice and for the purpose of taking his deposition in this action under the Federal Rules of Civil Procedure and particularly those which refer to discovery.

VINCENT I. WHITMAN
the plaintiff, having been first duly sworn by a notary public of the State of New York, testified as follows:

Direct Examination

By Mr. Caughey:

Q. What is your name and address, please?

A. Vincent I. Whitman, 431 Seventh Avenue, New York City. [2*]

*Page numbering appearing at top of page of original Reporter's Transcript of Record.

(Deposition of Vincent I. Whitman.)

Q. Mr. Whitman, are you the Mr. Whitman who is the patentee of Patent 2,075,684, which is the patent in issue in this particular action?

A. That's right.

Q. Are you the owner of that patent?

A. Yes.

Q. Are there any licenses outstanding that have been granted under that patent?

A. None whatever. Just to the Tri-Visional Company for use on making short subjects for television showing, but not use in motion pictures—motion picture use.

Q. Then, as I understand it, there are no licenses that have anything to do with motion picture photography? A. No.

Q. Are you the sole owner of the patent?

A. That's right.

Q. Have you any agreements whereby anybody is financing this particular litigation?

The Witness: How would that be?

Mr. Martin: I have been appointed and have papers stating that I am the—have the complete power of attorney on all of these matters, the business end and so on, for the case.

His brother died around two years ago and we were associated together until that time. When his brother [3] died, I took over completely because he was not the business end; his brother was the business end prior to his passing on.

Q. Mr. Whitman, you have heard what Mr.

(Deposition of Vincent I. Whitman.)

Martin has said. Is that in accordance with the facts? A. Yes.

Mr. Caughey: Off the record.

(Discussion off the record.)

Q. Then, as I understand it, Mr. Whitman, Mr. Martin is conducting your business affairs, is that correct? A. That's right.

Q. For how long a time has he been conducting your business affairs, approximately?

A. Six years, isn't it?

Mr. Caughey: Off the record.

(Discussion off the record.)

Q. I have been handed a document entitled Power of Attorney, which, as I understand it, is a duplicate-original of a Power of Attorney previously referred to and executed on July the 7th, 1953, is that correct, Mr. Whitman?

A. That's right.

Mr. Caughey: I ask that that be marked as Defendant's Exhibit A for identification.

(Duplicate-original of Power of Attorney described above was marked as Defendant's Exhibit A for identification.) [4]

Q. Mr. Whitman, you are aware, are you not, that there have been previous actions filed against the defendants, Walt Disney Productions, Inc., and perhaps Walter E. Disney and Roy O. Disney——

A. That's right.

(Deposition of Vincent I. Whitman.)

Q. ——in the past? A. In the past.

Q. One of those actions was filed in New York, was it not, in 1939, and was, thereafter, dismissed because of the inability to get jurisdiction over the particular defendants?

A. Yes; I think there was some mix-up.

Q. But you do recall there was a case filed in New York and subsequently dismissed in 1939?

A. That's right. Let's see—what time was that? Something about prejudice, wasn't it?

Q. That was for infringement of the same patent? A. The same one.

Q. And then, subsequently, there was another action filed in California, was there not?

A. Afterwards.

Q. On the same patent?

A. Same one. We followed that right up.

Q. And that was also against Walt Disney Productions, Inc.? A. That's right. [5]

Q. And against the individual defendants?

A. That's right.

Q. And that particular action was dismissed for lack of prosecution, was it not?

A. Let's see——

Mr. Bolton: If you don't know, say you don't know.

Q. If you know? A. I don't know.

Q. You do know it was dismissed for some reason?

A. Some reason, but I didn't know any details.

Q. Do you recall when that particular action was

(Deposition of Vincent I. Whitman.)

dismissed? A. No—quite awhile back.

Q. Do you recall the number of that particular action? A. No.

Mr. Caughey: May we stipulate the former action in California was No. 947?

Mr. Bolton: So stipulated.

Mr. Caughey: May it also be stipulated that an order dismissing the action without prejudice was filed on March the 30th, 1943?

Mr. Bolton: So stipulated.

Mr. Caughey: Which order was signed by Ben H. Harrison, United States District Judge for the Southern District of California. [6]

Mr. Bolton: So stipulated.

Q. Mr. Whitman, the particular action which we referred to and concerning which the stipulations were entered extended from 1940 to 1943 and the order which we just stipulated to was entered on March the 30th, 1943. Now, bearing that date in mind, March the 30th, 1943, have you ever contacted any of the defendants, Walt Disney Productions, Inc., Walter E. Disney, or Roy O. Disney, since that time in connection with the alleged infringement of the patent in suit?

A. Yes; I think we did.

Q. Since that time? A. Yes.

Q. When, do you recall?

A. Oh, that's—I can't recall when.

Q. Mr. Whitman, do you recall in what manner you contacted any of the defendants, whether it was in writing or by person or what?

(Deposition of Vincent I. Whitman.)

A. By mail.

Q. In writing?

A. Writing—by mail. It was served by mail out there.

Q. Served by mail? A. Yes.

Q. And that was some time after 1943?

A. Through that time. I can't pin it right down to the actual time. [7]

Q. Have you any copies of any such correspondence? A. Yes; sure.

Q. Have you any copies of any such correspondence directed to the defendants?

A. All kinds.

Q. Mr. Whitman, do you recall the last time that you contacted any of these named defendants relative to alleged infringement of the patent in suit?

A. Oh, I'd say 1943—it would be guesswork, though.

Q. You haven't done so within the last seven or eight years? A. Yes.

Q. When was the last year that you had any contact with the defendants relative to this alleged infringement?

A. It was only a few years ago. He's got dates there. I wouldn't know the dates.

Mr. Caughey: Now, I ask that any and all correspondence which was had with Walt Disney Productions, Inc., Walter E. Disney or Roy O. Disney or their attorneys relative to alleged infringement of the patent in suit be supplied to the defendants.

(Deposition of Vincent I. Whitman.)

Mr. Bolton: Off the record.

(Discussion off the record.)

Mr. Caughey: It has been suggested that the attorney of record, Mr. Brown, has copies of all such correspondence. [8]

Q. Would it be in order, Mr. Whitman, for me to contact Mr. Brown to see if he is willing to produce such correspondence? A. Yes.

Q. Now, the case which was filed in California which we have referred to and identified as 947-B was also filed against Walt Disney Productions, Inc., Walter E. Disney and Roy O. Disney, was it not?

A. That's right.

Q. That is the same named individuals as in this present case?

A. I think it was filed against the corporation—the Disney Corporation.

Mr. Caughey: I have named the Disney Corporation.

The Witness: Oh, I see. That's correct.

Q. Mr. Whitman, when you filed the action in 1940, I assume that you had some information prior to filing the action upon which you based the filing of the action for infringement, is that correct?

A. Plurality of plates, both dimensional and still.

Q. Where did you get that information?

A. I have seen their picture at Radio City—Seven Dwarfs picture.

Q. Did you also see their Snow White picture?

(Deposition of Vincent I. Whitman.)

A. That's the same thing. [9]

Q. I beg your pardon. I didn't mean Snow White. I meant Pinocchio.

A. I saw that one, too.

Q. Did you also base the suit on that one?

A. Same thing, same thing. [10]

* * *

Q. Since 1943, what have you been doing, Mr. Whitman? Beginning in 1943, if you can, I would like you to tell me what you have been doing from year to year, what your business has been?

A. Well, my brother, who handled the business side of it, he sold assignments in our patents to keep the business going—profits to be derived from any patent arrangement with Disney or anybody else. That's what kept us going. [15]

Q. Outside of that, did you do something yourself? Did you work or something? Did you have some vocation?

The Witness: You mean doing ordinary work?

Q. Yes.

A. Yes. I was a timekeeper at the Piccadilly Hotel two years ago—night watchman there, too.

Q. Was that two years ago?

A. How long ago was that? And I'm working now at the American Blueprint Company, a couple of blocks away.

Q. How long have you been employed there?

A. About five months.

Q. Prior to that, you were with what concern?

(Deposition of Vincent I. Whitman.)

A. I was with the Piccadilly as timekeeper and watchman. Up to that time he sold assignments for profits to be derived.

Q. When you say "he," you are referring to your brother? A. That's right.

Q. So you went to work for the Piccadilly Hotel approximately two years ago?

A. I imagine so—yes. He passed away two years ago.

Q. Am I to understand you that from 1943 to 1953, you did nothing except live on what your brother gave you? A. That's right.

Q. Derived—— A. From profits.

Q. ——from profit of assignments he sold in and to [16] various patents? A. That's right.

Q. And you did nothing else?

A. No. I worked on our inventions all the time.

Q. You continued to work on various inventions?

A. I do that right now. I'm always working on those things. He did all the business end of it.

Q. Your brother conducted all the business affairs—— A. All the business.

Q. ——from 1943 up to the time of his death in 1953?

A. That's right. When he passed away, Mr. Martin took over.

Q. So that, your only source of income from 1943 to 1953 was what your brother gave you——

A. That's right.

Q. ——from these particular profits?

A. That's right.

(Deposition of Vincent I. Whitman.)

Q. Was that amount that your brother gave you substantial?

A. Yes. We lived together; paid all of our expenses.

Q. You paid your expenses? A. Yes.

Q. Where did you live?

A. A dozen places.

Q. Did you own any of the homes in which you lived?

A. These were all hotels. Want the names of them? [17] There's quite a list of them.

Q. Did you and your brother conduct a business during that period of time?

The Witness: What do you mean by "business"?

Q. What I mean——

The Witness: I'd call that a business, selling assignments on a speculation basis for profits to be derived.

Q. Did you do business under any particular name? A. No—just assignments.

Q. Did your brother use his hotel as an office?

A. That's right.

Q. And you used a hotel as an office, also?

A. I worked there on my inventions.

Q. Are you married, Mr. Whitman?

A. I was.

Q. When you say you were, when did you cease being married?

A. Oh, ever since 1923—between '22 and '23.

Q. So, from 1943 to date, you haven't been married? A. No.

(Deposition of Vincent I. Whitman.)

Q. Have you had any dependents that you have had to take care of during that period of time?

A. No.

Q. Referring to the profits which, as you call them, were [18] made either by you or your brother in conjunction, I suppose you worked together?

A. I didn't handle that at all. All I had to do was sign the assignment. I didn't pay any attention to the transaction or the people involved.

Q. Did you have some agreement with your brother whereby he paid you a certain amount of that?

A. No. I trusted him. He run the whole business; paid all the bills and made out all the assignments. All I had to do was sign them. I didn't care who he made them to.

Q. As I understand it, he took care of all your expenses during that period of time?

A. That's right.

Q. Did he pay you a salary or anything in addition?

A. When I'd ask him for the money, he would give it to me.

Q. Was your brother at that time conducting your business affairs? A. All of it.

Q. At the time this prior suit was filed in California in 1940, was your brother the one that handled that? A. All of that.

Q. He was the one instrumental in seeing the action was——

A. That's right. He handled all the legal proce-

(Deposition of Vincent I. Whitman.)

dure right straight through. I had nothing to do with that part at [19] all.

Q. Therefore, you might say he was in the same position as Mr. Martin is at the present time?

A. That's right. In other words, he took his place.

Q. Even though there wasn't any formal power of attorney executed?

A. That's right. He's legal minded, you know.

Q. The amounts or profits which you have spoken about which were derived from selling assignments or from the exploitation of the inventions, were those sums considerable in amount over the period of years?

A. Well, they were in the thousands of dollars. I don't know the exact amount.

Q. Your brother died in 1953?

A. About two years ago.

Q. I presume he left an estate at that time?

A. No.

Q. May I ask approximately what salary you received at the Piccadilly Hotel in the period of time you worked there?

A. Oh, about four—$48. That's plus social security.

Q. What is your present salary where you are now employed?

A. It's $30 for five days for the first six months. I understand then you get a raise. I just went there about five months, I guess.

Q. Mr. Whitman, let me kind of check back on

(Deposition of Vincent I. Whitman.)

this thing [20] a minute. From 1943 to 1953, up to the time your brother passed away, you lived with him? A. That's right.

Q. And he took care of all your business affairs?

A. And paid all expenses and he looked after all the legal and court actions. He would run down to the library every day and copy all the things going on.

Q. Would it be fair to say, Mr. Whitman, that during that period of time, that the amount of royalties or profits which your brother received amounted to approximately $50,000?

The Witness: Royalties? You wouldn't call that royalty.

Q. Profits.

A. Well, the profit—the investor and speculator, he invests in the profit.

Q. How much did your brother obtain?

A. All told—oh, it would only be guesswork. Well, that must be—you're talking about prior to Disney?

Q. No. From 1943 to 1953.

The Witness: That's a tough question.

Mr. Caughey: If you don't know, don't answer it.

A. (Continued): Thousands of dollars—maybe more than that.

Q. It might be more than $50,000?

A. There were an awful lot of people involved in it— [21] enough stuff to fill this room.

Q. As I understand you, during that ten-year period, 1943 to 1953, you were working only on in-

(Deposition of Vincent I. Whitman.)

ventions? A. That's right.

Q. You didn't go out and get any jobs——

A. No.

Q. ——in any motion picture producing concern? A. No.

Q. You were fully qualified to do so?

A. I could have.

Q. Probably could have commanded a very good salary? A. Probably could have.

Q. After this action was dismissed in 1943, which we previously referred to, why did you wait ten years, to 1953, to bring the next action against the defendants? A. Lack of funds, I guess.

Q. Lack of funds? A. Yes.

Q. Did you ask your brother to take any action against the Disneys?

A. I wouldn't know why. He did all that. He was continuously raising money for the purpose. He said he was going after Disney. He needed this money to finance him, to defray all the expenses.

Q. Did you talk it over with your brother that action [22] should be brought? A. No.

Q. You didn't mention it to him——

A. No.

Q. ——your brother?

A. He never asked me about anything.

Q. Your brother, as a matter of fact, had sufficient money if he so desired to go ahead, didn't he?

A. Yes; I guess he could have. Maybe he did; maybe he did go ahead. I wouldn't know.

Q. Now, when this action was brought in 1953,

(Deposition of Vincent I. Whitman.)

did you base it upon any other additional facts that you secured in the meantime other than the facts you had when you filed the original action in Los Angeles?

The Witness: You mean technical facts?

Q. Facts to the question of infringement.

The Witness: You mean the patent itself?

Q. Let's put it this way: At the time that you filed the action in 1940, you stated that you had seen Snow White and the Seven Dwarfs and Pinocchio, and from your looking at those pictures, you concluded that Disney was infringing. Now, what additional facts upon the question of infringement did you learn between 1943 and 1953?

The Witness: The time of the first violation, you mean? [23]

Q. No. I'm talking about the period of time after the action was dismissed in Los Angeles, and I am asking you whether or not there were additional facts upon the question of infringement that you learned?

A. Oh—I see. In that particular patent?

Q. That you learned relative to this particular patent prior to the time you filed this last action in 1953.

A. Let's see. I don't think there was any development there, because that's a basic invention. You can't tack anything onto it.

Mr. Caughey: Mr. Whitman, I'll go a little slower, and please listen carefully to my question. My question was this:

(Deposition of Vincent I. Whitman.)

Q. After explaining to you that you had previously testified that the original action was brought after you had seen Snow White and the Seven Dwarfs and Pinocchio, and you had concluded that Disney was infringing your patent——

A. That's right.

Q. ——then you filed that action?

A. That's right.

Q. Then it was dismissed?

A. That's right.

Q. Now, my question is, between that period of dismissal in 1943 and the time that you filed this present action in 1953, what additional information or facts upon the question [24] of infringement, infringement only by Disney, did you find out or learn that caused you to conclude that they had continued to infringe?

A. That was enough—just that picture. I had seen one picture. I've seen them all. They're all made the same way.

Mr. Bolton: As Snow White and Pinocchio?

The Witness: That's right. I saw all of them, but they're all made the same way.

Q. I don't want to mislead you at all, so if there are any pictures you saw in the interim from 1943 to 1953 which you concluded Disney made which you concluded were made in the same way as Snow White and the Seven Dwarfs and Pinocchio, I want you to state what they were.

A. Fantasia, The Whale at the Opera—let's see—and a few shorts that you see at the Trans-Lux.

(Deposition of Vincent I. Whitman.)

They have no particular name. These were features I just told you, but there's a few shorts at the Trans-Lux. You see, they turn out about a thousand feet.

Q. How about Cinderella?

A. I didn't see that.

Q. And you didn't see Peter Pan? A. No.

Q. Did you see the reissue of Snow White?

A. No.

Q. Would you consider that a reissue of Snow White was [25] any added infringement of the original? A. No.

Q. Now, motion pictures which were put out by Disney which you saw after 1943 and which you have referred to, from the way you saw them, you looked at them, they were made in identically the same manner—— A. Exactly.

Q. ——as Snow White and the Seven Dwarfs?

A. Exactly.

Q. That is, they were plates, plurality of plates, is that correct?

A. That's right, or a panaramic job.

Q. Upon which there were images?

A. Opaque images—a character on the front and opaque in the back.

Q. And with the rest of the plate transparent—— A. All of them were.

Q. ——except where the images were?

A. The images—the opaque keeps it—blocks out the under job, what's below it. If you didn't do that, you would see right through. It would be a mess.

Q. So that this particular plate with the image

(Deposition of Vincent I. Whitman.)

on it was placed in front of a camera and photographed together with visual scenes to make a composite picture? A. That's right. [26]

Q. How about the lighting in these subsequent pictures? Did they seem to be the side lighting?

A. The same thing. They all practically use the same thing—side lighting. They have to use side lighting. There is no other way.

Q. How has your health been all this period of time? A. I have been working.

Q. Your health has been okay——

A. Okay.

Q. ——from 1943?

A. I went all over the City as a messenger. Right along from 1943?

Q. Yes. A. All right, as far as I know.

Q. And this managing of your affairs by your brother and subsequently by Mr. Martin was because, as a matter of fact, you're more of an inventor type? A. That's right.

Q. And you didn't know anything about business affairs—— A. That's right.

Q. ——and wanted somebody to take over, isn't that correct? A. That's right.

Q. And you relied upon them to conduct your affairs?

A. That's right. He does the same thing my brother did. [27]

Q. Prior to the time your brother passed away, as a matter of fact, Mr. Martin was also assisting, wasn't he?

(Deposition of Vincent I. Whitman.)

A. Well, yes. They were in business together—Tri-Vision.

Q. What is this "Tri-Vision"?

A. That's TV commercial job, using this particular patent you've got there to send commercials over TV like they're doing now that you have on your TV.

Q. In what way in the connection of the business of Tri-Vision do you use this particular patent?

A. The same way you would in a regular animation job. We make the 35 mm. job first, same as in animation. Then we take it by TV camera and transmit it over the air and you get it in your receiver.

Q. Have you used it for all the plates?

A. Exactly.

Q. Do you paint on those plates or are they positive prints? A. All painting, all art jobs.

Q. Painted on glass?

A. That's right, or celluloid, either one—any transparent job.

Q. Then you photograph compositely the——

A. The same as you do in animation.

Q. The same as you previously described? [28]

A. Yes. Didn't he show you those plates?

Q. Mr. Whitman, during this period of time from 1943 to 1953, have you taken any action against any other concerns because of any infringement of this particular patent?

A. No; because I understand that's an adjudication of Disney—the rest of them will follow suit, won't they, if they have to pay?

(Deposition of Vincent I. Whitman.)

Q. I merely asked you whether during this period of time you took any action against anybody else.

A. No. I just went after Disney—he's the [29] biggest.

* * *

Q. Now, Mr. Whitman, Walter E. Disney and Roy O. Disney were joined in this action, also, as they were in the previous actions which were dismissed? A. That's right.

Q. Is there anything that Walter E. Disney or Roy O. Disney did over and above their connection with the corporation as officers of the corporation which caused you to bring this action? Was there any separate acts of infringement they did? [61]

A. No, just because——

Mr. Bolton: Can he answer that question?

A. ——it's a large corporation. We went after the corporation.

Mr. Martin: It's a legal question.

Mr. Caughey: It isn't a legal question at all.

Off the record.

(Discussion off the record.)

Q. Mr. Whitman, what I was trying to elicit from my question—the information I was trying to get: The reason Walter E. Disney and Roy O. Disney were joined as defendants was because of their connection with the Disney Corporation?

A. That's right.

(Deposition of Vincent I. Whitman.)

Q. And not because that they individually and separately went out and infringed themselves?

A. No—the corporation.

Q. So that any acts of infringement were charged against Walter E. Disney and Roy O. Disney were because of what the corporation had done?

A. I think Roy was the President of the corporation.

Mr. Caughey: Walter Disney is Chairman of the Board, I believe.

The Witness: That makes them the corporation.

Q. That's the reason? A. Yes. [62]

Mr. Bolton: Off the record.

(Discussion off the record.)

Q. Mr. Whitman, I note in this complaint that was filed there are a lot of John Does and Jane Does. Do you know of anybody else at the present time other than the named defendants who were connected with Disney Corporation who were part of this infringing—— A. No.

Q. ——action? Do you know of any people who are particularly named as John and Jane Does that should be joined in here as defendants?

A. No.

Q. Mr. Whitman, the complaint in this action was filed as I previously stated on July 30th, 1953?

A. That's right.

Q. However, the summons in this action—and that is the thing you serve on somebody to bring them into Court—was not served until January the

(Deposition of Vincent I. Whitman.)

19th, 1955. Now, can you tell me why that delay occurred? A. He can. I wouldn't know.

Q. You wouldn't know? A. No.

Q. That was something that you left in the hands of the people who are tending to your business affairs, is that correct? A. That's right. [63]

Q. You never personally, Mr. Whitman, talked to either Walter Disney, Roy Disney or any other officer of Walt Disney Productions, Inc., about this alleged infringement? A. No.

Q. As I understand it you never even personally directed any letters to them? A. No.

Q. That was done by somebody else?

A. No.

Q. So that everything that was done in connection with the bringing of these actions and the notifying or correspondence in connection with infringement was done by somebody else; not by you?

A. That's right.

Q. By the people who were managing your business affairs whom you previously testified to?

A. That's right. They went ahead and done these things unbeknownst to me.

Mr. Bolton: They did it under your authority, though?

Q. Were they done with your authority?

A. I wouldn't know enough to give them authority. I'm not a lawyer.

Mr. Bolton: Did you authorize them to do these things?

The Witness: Yes. I knew they were going on,

(Deposition of Vincent I. Whitman.)

but I didn't [64] know the arrangements. They go right ahead and makes these things, papers, out—send them out there and take down these files.

Q. You know, Mr. Whitman, that a suit was dismissed in 1943? A. Yes.

Q. And you knew that it wasn't again brought until 1953? You knew that much?

A. A few things I knew was going on—I said "without prejudice."

Q. You knew the action was dismissed without prejudice? A. That's right.

Q. And you knew also it wasn't filed again until 1953? A. I can't go by the dates. I know——

Q. Put it this way: You——

A. I knew we were keeping it going.

Mr. Caughey: Just a second.

Q. You knew another action wasn't filed until the present action was filed in 1953, No. 15764?

A. I couldn't tell whether he put any other actions in there or not. Do you know?

Q. I'm asking you. A. I wouldn't know.

Q. You don't know whether there were any other actions filed between 1943 and 1953 or [65] not?

A. No, I can't. I'd be guessing. I'd have to look it up in some of these papers he's got.

Q. Put it this way: If any other actions were filed, you haven't any knowledge of it?

A. No; I haven't any present knowledge of it.

* * *

[Endorsed]: Filed October 31, 1955. [66]

[Endorsed]: No. 15608. United States Court of Appeals for the Ninth Circuit. Vincent I. Whitman, Appellant, vs. Walt Disney Productions, Inc., Appellee. Transcript of Record. Appeal from the United States District Court for the Southern District of California, Central Division.

Filed June 28, 1957.

/s/ PAUL P. O'BRIEN,
Clerk of the United States Court of Appeals for the Ninth Circuit.

United States Court of Appeals
for the Ninth District

VINCENT I. WHITMAN,

Appellant,

vs.

WALT DISNEY, ROY DISNEY, WALT, DISNEY PRODUCTIONS, INC., et al.,

Appellee.

STATEMENT OF POINTS ON WHICH THE APPELLANT INTENDS TO RELY ON THE APPEAL

1. That the Decision of Judge Ben Harrison Is Contrary to Law and Fact.

2. Many Definite Errors Presented by Lyon & Lyon, Attorneys for Disney.

3. The Total Ignoring of Plaintiff's Supplemental Brief, Submitted by the Attorney of Record for Plaintiff, Vincent I. Whitman, by William J. F. Brown, Attorney of Record From 1943 to 1957, Presented to and Suggested by, Hon. Judge Ben Harrison.

4. Lyon & Lyon Were Fully Informed of This Action Through 1943 to 1949, as Well as Before 1953.

VINCENT I. WHITMAN,
Appellant Pro Se;

/s/ JULIAN A. MARTIN,
Power of Attorney.

[Endorsed]: Filed July 27, 1957.